

REMARKS:

Claims 1-43 are currently pending in the application. Claims 11-26, 37-40 and 42 are withdrawn from consideration. Claims 1, 27, 41, and 43 stand rejected under 35 U.S.C. § 103(a) over U.S. Patent No. 6,708,161 to Tenorio et al. (“*Tenorio*”) in view of U.S. Patent No. 6,366,910 to Rajaraman et al. (“*Rajaraman*”). Claims 2, 7-10, 28, and 33-36 stand rejected under 35 U.S.C. § 103(a) over *Tenorio* in view of *Rajaraman* in further view of U.S. Patent No. 6,078,891 to Riordan et al. (“*Riordan*”) and in further view of U.S. Patent No. 6,578,014 to Murcko Jr. (“*Murcko*”). Claims 3, 4, 6, 29, 30, and 32 stand rejected under 35 U.S.C. § 103(a) over *Tenorio* in view of *Rajaraman* and in further view of *Murcko*.

REJECTION UNDER 35 U.S.C. § 103:

Claims 1, 5, 27, 31, 41, and 43 stand rejected under 35 U.S.C. § 103(a) over *Tenorio* in view of *Rajaraman*. Claims 2, 7-10, 28, and 33-36 stand rejected under 35 U.S.C. § 103(a) over *Tenorio* in view of *Rajaraman* in further view of *Riordan* and in further view of *Murcko*. Claims 3, 4, 6, 29, 30, and 32 stand rejected under 35 U.S.C. § 103(a) over *Tenorio* in view of *Rajaraman* and in further view of *Murcko*.

The Applicant respectfully submits that *Tenorio* or *Rajaraman*, either individually or in combination, fail to disclose, teach, or suggest each and every element of claims 1, 5, 27, 41, and 43. The Applicant further submits that *Tenorio*, *Rajaraman*, *Riordan*, or *Murcko*, either individually or in combination, fail to disclose, teach, or suggest each and every element of claims 2, 7-10, 28, and 33-36. The Applicant still further submits that *Tenorio*, *Rajaraman*, or *Murcko*, either individually or in combination, fail to disclose, teach, or suggest each and every element of claims 3, 4, 6, 29, 30, and 32. Thus, the Applicant respectfully traverses the Examiners obvious rejection of claims 1-10, 27-36, 41, and 43 under 35 U.S.C. § 103(a) over the proposed combination of *Tenorio*, *Rajaraman*, *Riordan*, and *Murcko* either individually or in combination.

***Tenorio* is Disqualified as prior art under 35 U.S.C. § 103(a)**

The Applicant respectfully submits that *Tenorio* is disqualified as prior art under 35 U.S.C. § 103 in the subject Application. The Applicant further submits that:

the subject Application and the Tenorio U.S. Patent were, at the time the invention was made, owned by, or subject to an obligation of assignment to, the same entity, i2 Technologies US, Inc.

Thus, in accordance with 35 U.S.C. § 103(c) and MPEP 706.02(I)(1), *Tenorio* is disqualified as prior art under 35 U.S.C. § 103(a) in the subject Application. Thus, the Applicant respectfully request that the rejection of the claims under 35 U.S.C. § 103(a) be reconsidered and that claims 1-36 be allowed.

The Proposed *Tenorio-Rajaraman* Combination Fails to Disclose, Teach, or Suggest Various Limitations Recited in Applicant's Claims

For example, with respect to independent claim 1, this claim recites:

A system providing seller pre-qualification during the matching phase of an electronic commerce transaction, comprising:

a directory structure comprising a plurality of hierarchically organized product classes, each product class categorizing a plurality of products and defining one or more attributes of the products categorized in the product class;

one or more pointers for each product class, each pointer identifying a seller database in which product data enabling a product transaction is stored for products categorized in the product class, each seller database associated with a seller having values for one or more seller attributes; and

a search interface operable to communicate, in response to selection of a product class and specification of one or more seller attribute criteria, a search query for product data only to one or more seller databases associated with sellers having seller attribute values matching the specified seller attribute criteria, these seller databases being identified by the one or more pointers associated with the selected product class. (Emphasis Added).

Independent claims 27, 41, and 43 recite similar limitations. *Tenorio* or *Rajaraman*, either individually or in combination, fail to disclose each and every limitation of independent claims 1, 27, 41, and 43.

The Applicant respectfully submits that the Office Action acknowledges, and Applicant agrees, that *Rajaraman* fails to disclose the emphasized limitations noted above in independent claim 1. Specifically the Examiner acknowledges that *Rajaraman* fails to disclose “using a seller [sic] profile for searching in addition to a buyer’s query”. (19 October 2005 Office Action, Page 3). However, the Examiner asserts that the cited portions of *Tenorio* teach the acknowledged shortcomings in *Yamashita*. (19 October 2005 Office Action, Page 3). The Applicant respectfully disagrees. ***As mentioned above, Tenorio is disqualified as prior art under 35 U.S.C. § 103.*** Since, *Tenorio* is disqualified as prior art, it will not be discussed further. Thus, the Applicant respectfully submits that the prior art forming the foundation of the Examiner’s obvious rejection between *Rajaraman* and independent claim 1 cannot be made. The Applicant further submits that this distinction alone is sufficient to patentably distinguish independent claim 1 from *Rajaraman*.

In addition, the Applicant respectfully maintains that *Rajaraman* fails to disclose “***a directory structure comprising a plurality of hierarchically organized product classes, each product class categorizing a plurality of products and defining one or more attributes of the products categorized in the product class.***” Although *Rajaraman* discloses a system for querying hierarchically classified data, (Abstract), *Rajaraman* does not disclose defining one or more attributes of products categorized in the plurality of hierarchically organized product classes. In fact, ***Rajaraman teaches away from the claimed invention*** since the first query request received by *Rajaraman* is inefficient because of the large amount of searching involved in finding a product classification. Furthermore, once *Rajaraman* displays the various offerings of that product classification there are various sub-classifications based on the hierarchy of classifications that cannot be easily resolved or adjusted.

The Applicant further maintains that *Rajaraman* does not disclose “***one or more pointers for each product class, each pointer identifying a seller database in which product data enabling a product transaction is stored for products categorized in the product class,*** each seller database associated with a seller having values for one or more seller attributes”. Although *Rajaraman* discloses a pointer to the

entries of a term table that contain that term; the pointer is only contemplated for use provided a term exists in the term table. (Column 7, Lines 43-61). *Rajaraman* does not point to a seller database, where product data is stored for products characterized in the plurality of hierarchically organized product classes.

The Applicant still further maintains that *Rajaraman* does not disclose “**a search interface operable to communicate, in response to selection of a product class and specification of one or more seller attribute criteria, a search query for product data only to one or more seller databases associated with sellers having seller attribute values matching the specified seller attribute criteria, these seller databases being identified by the one or more pointers associated with the selected product class.**” As mentioned above, *Rajaraman* does not disclose a pointer identifying a seller database in which product data enabling a product transaction is stored for products categorized in the product class. Thus, *Rajaraman* cannot provide a search interface operable to communicate, in response to selection of a product class, since *Rajaraman* does not even provide a pointer associated with the selected product class.

The Proposed *Tenorio-Rajaraman-Riordan-Murcko-Official-Notice* Combination Fails to Disclose, Teach, or Suggest Various Limitations Recited in Applicant’s Dependent Claims 2 and 28

The Applicant respectfully submits that *Tenorio*, *Rajaraman*, *Riordan*, and *Murcko*, either individually or in combination, fail to disclose, teach, or suggest each and every element of dependent claims 2 and 28. Thus, the Applicant respectfully traverses the Examiner’s obvious rejection of dependent claims 2 and 28 under 35 U.S.C. § 103(a) over the proposed combination of *Tenorio*, *Rajaraman*, *Riordan*, and *Murcko*, either individually or in combination.

For example, with respect to dependent claim 2, this claim recites:

The system of Claim 1 , wherein **a seller attribute is selected from the group consisting of geographic restrictions, currencies accepted, level of buyer credit required, collaboration tools accepted, types of contracts accepted, and contract terms accepted.** (Emphasis Added).

Dependent claim 28 recites similar limitations. *Tenorio, Rajaraman, Riordan, and Murcko*, either individually or in combination, fail to disclose, teach, or suggest each and every element of dependent claims 2 and 28.

The Applicant respectfully submits that the Office Action acknowledges, and Applicant agrees, that *Tenorio* or *Rajaraman* fail to disclose the emphasized limitations noted above in dependent claim 2. Specifically the Examiner acknowledges that ***Tenorio or Rajaraman fail to disclose “wherein a seller attribute is selected from the group consisting of geographic restrictions, currencies accepted, level of buyer credit required, collaboration tools accepted, types of contracts accepted, and contract terms accepted”***. (19 October 2005 Office Action, Page 5). However, the Examiner asserts Official Notice over the acknowledged shortcomings in *Tenorio* and *Rajaraman*. (19 October 2005 Office Action, Page 5). The Applicant respectfully disagrees. ***As mentioned above, Tenorio is disqualified as prior art under 35 U.S.C. § 103.*** Since, *Tenorio* is disqualified as prior art, it will not be discussed further. The Applicant respectfully traverses the Examiner's obvious rejection of dependent claims 2 and 28 under 35 U.S.C. § 103(a) over the proposed combination of *Tenorio, Rajaraman, Riordan, Murcko*, and the Examiner's purported Official Notice, either individually or in combination.

The Applicant further submits that the Applicant is confused as to what the Examiner is intending to teach by the purported Official Notice or even the extent in which the Examiner is taking Official Notice. ***The Applicant respectfully requests clarification as to the subject matter for which the Examiner is taking Official Notice.*** The Examiner alleges that the limitations in dependent claim 2 are "old and well-known". (19 October 2005 Office Action, Page 5). The Applicant respectfully traverses the purported Official Notice because the asserted facts, as best understood by the Applicant, are not supported by substantial documentary evidence or any type of documentary evidence and appear to be the Examiner's opinions formulated using the subject Application as a template, which constitutes impermissible use of hindsight. Furthermore, under these circumstances, ***it is inappropriate for the Examiner to take Official Notice without***

documentary evidence to support the Examiner's conclusion. (See MPEP § 2144.03). The Applicants respectfully request the Examiner to produce authority for the Examiner's purported Official Notice.

Only "in limited circumstances," is it "appropriate for an examiner to take official notice of facts not in the record or to rely on common knowledge in making a rejection". (MPEP § 2144.03). "Official notice unsupported by documentary evidence should only be taken by the examiner where the facts asserted to be well-known, or to be common knowledge in the art are **capable of instant and unquestionable demonstration as being well-known**. As noted by the court in *In re Ahlert*, 424 F.2d 1088, 1091, 165 USPQ 418, 420 (CCPA 1970), the notice of facts beyond the record which may be taken by the examiner must be '**capable of such instant and unquestionable demonstration as to defy the dispute**' (citing *In re Knapp Monarch Co.*, 296 F.2d 230, 132 U.S.P.Q. 6 (C.C.P.A. 1961))." (MPEP § 2144.03(A)). (Emphasis Added).

"***It is never appropriate to rely solely on "common knowledge" in the art without evidentiary support in the record***, as the principal evidence upon which a rejection was based. *Zurko*, 258 F.3d at 1385, 59 USPQ2d at 1697. As the court held in *Zurko*, an assessment of basic knowledge and common sense that is not based on any evidence in the record lacks substantial evidence support. *Id.* at 1385, 59 USPQ2d at 1697. See also *In re Lee*, 277 F.3d 1338, 1344-45, 61 USPQ2d 1430, 1434-35 (Fed. Cir. 2002)." (MPEP § 2144.03(A)).

"Ordinarily, there must be some form of evidence in the record to support an assertion of common knowledge. See *Lee*, 277 F.3d at 1344-45, 61 USPQ2d at 1434-35 (Fed. Cir. 2002); *Zurko*, 258 F.3d at 1386, 59 USPQ2d at 1697 (holding that **general conclusions concerning what is "basic knowledge" or "common sense" to one of ordinary skill in the art without specific factual findings and some concrete evidence in the record to support these findings will not support an obviousness rejection**). The examiner must provide specific factual findings predicated on sound technical and scientific reasoning to support his or her conclusion of common knowledge. See *Soli*, 317 F.2d at 946, 37 USPQ at 801; *Chevenard*, 139 F.2d at 713, 60 USPQ at

241. The applicant should be presented with the explicit basis on which the examiner regards the matter as subject to official notice and be allowed to challenge the assertion in the next reply after the Office action in which the common knowledge statement was made." (MPEP § 2144.03(B)). (Emphasis Added).

The Applicant respectfully submits that ***the Office Action provides no documentary evidence to support the purported Official Notice taken by the Examiner***, yet the asserted facts are not capable of "instant and unquestionable" demonstration as being well-known. The Applicants further submit that the Applicants have adequately traversed the Examiner's assertion of Official Notice and direct the Examiner's attention to the pertinent text of the MPEP, which states:

If applicant adequately traverses the examiner's assertion of official notice, the examiner must provide documentary evidence in the next Office action if the rejection is to be maintained. See 37 CFR 1.104(c)(2). See also Zurko, 258 F.3d at 1386, 59 USPQ2d at 1697 ("[T]he Board [or examiner] must point to some concrete evidence in the record in support of these findings" to satisfy the substantial evidence test). If the examiner is relying on personal knowledge to support the finding of what is known in the art, the examiner must provide an affidavit or declaration setting forth specific factual statements and explanation to support the finding. See 37 CFR 1.104(d)(2). (MPEP § 2144.03(C)).

Thus, if the Examiner continues to maintain the rejection of dependent claims 2 and 28 based on the Examiner's Official Notice, the Applicant respectfully requests that the Examiner provide documentary evidence as necessitated by MPEP § 2144.03(C). Furthermore, if the Examiner is relying on personal knowledge to support the finding of what is known in the art, the Applicants further request that the Examiner provide an Affidavit or Declaration setting forth specific factual statements and explanation to support the finding as further necessitated by MPEP § 2144.03(C).

In addition, the Applicant respectfully points the Examiner to the pertinent sections of the MPEP, directly on point to determine whether the next Office Action should be made Final. In particular, the Applicant respectfully directs the Examiner's attention to MPEP § 2144.03(D), which states:

If the examiner adds a reference in the next Office action after applicant's rebuttal, and the newly added reference is added only as directly corresponding evidence to support the prior common knowledge finding, and it does not result in a new issue or constitute a new ground of rejection, the Office action may be made final. If no amendments are made to the claims, the examiner must not rely on any other teachings in the reference if the rejection is made final. *If the newly cited reference is added for reasons other than to support the prior common knowledge statement and a new ground of rejection is introduced by the examiner that is not necessitated by applicant's amendment of the claims, the rejection may not be made final.* (MPEP § 2144.03(D)).

The Applicant further submits that the Office Action has failed to properly establish a *prima facie* case of obviousness based on the proposed combination of *Rajaraman, Riordan, and Murcko*, either individually or in combination. *The Office Action has not shown the required teaching, suggestion, or motivation in these references or in knowledge generally available to those of ordinary skill in the art at the time of the invention to combine Rajaraman, Riordan, and Murcko as proposed.* The Office Action merely states that "it would have been obvious to one of ordinary skill in the art at the time of invention to combine *Tenorio* and *Rajaraman* to suggest of [sic] selecting attributes from geographic restrictions, currencies accepted, level of buyer credit required, collaboration tools accepted, types of contracts accepted, or contract terms accepted [sic] buyer's query". (19 October 2005 Office Action, Pages 5-6). The Applicant respectfully disagrees.

The Applicant further submits that this purported advantage relied on by the Examiner is nowhere disclosed, taught, or suggested in *Rajaraman, Riordan, and Murcko*, either individually or in combination. In essence, the Examiner asserts that one of ordinary skill in the art at the time of the invention would have been motivated "because these choices would limit search results to come up with [sic] a preferred product and seller that fit with said buyer's requirement." (19 October 2005 Office Action, Page 6). The Applicant respectfully disagrees. *The Applicant respectfully requests the Examiner to point to the portions of Rajaraman, Riordan, and Murcko which contain the teaching, suggestion, or motivation to combine Rajaraman, Riordan, and Murcko for the Examiner's stated purported advantage.* The Applicant further submits that the

Examiner is using the subject Application as a template to formulate reconstructive hindsight, which constitutes impermissible use of hindsight under 35 U.S.C. § 103(a).

A recent Federal Circuit case makes it crystal clear that, in an obviousness situation, the ***prior art must disclose each and every element of the claimed invention***, and that ***any motivation to combine or modify the prior art must be based upon a suggestion in the prior art***. *In re Lee*, 61 U.S.P.Q.2d 1430 (Fed. Cir. 2002). (Emphasis Added). Conclusory statements regarding common knowledge and common sense are insufficient to support a finding of obviousness. *Id.* at 1434-35. With respect to the subject Application, the Examiner has not adequately supported the selection and combination of *Rajaraman*, *Riordan*, and *Murcko* to render obvious the Applicant's claimed invention. ***The Examiner's conclusory statements*** that "it would have been obvious for one of ordinary skill in the art at the time of invention to combine *Tenorio* and *Rajaraman* to suggest of [sic] selecting attributes" and "because these choices would limit search results", ***does not adequately address the issue of motivation to combine***. (19 October 2005 Office Action, Pages 5-6). This factual question of motivation is material to patentability, and cannot be resolved on subjective belief and unknown authority. *Id.* It is improper, in determining whether a person of ordinary skill would have been led to this combination of references, simply to "[use] that which the inventor taught against its teacher." *W.L. Gore v. Garlock, Inc.*, 721 F.2d 1540 (Fed. Cir. 1983). Thus, the Office Action fails to provide proper motivation for combining the teachings of *Rajaraman*, *Riordan*, and *Murcko*, either individually or in combination.

The Proposed *Tenorio-Rajaraman-Riordan-Murcko* Combination Fails to Disclose, Teach, or Suggest Various Limitations Recited in Applicant's Dependent Claims 7-10 and 33-36

The Applicant respectfully submits that *Tenorio*, *Rajaraman*, *Riordan*, and *Murcko*, either individually or in combination, fail to disclose, teach, or suggest each and every element of dependent claims 7-10 and 33-36. Thus, the Applicant respectfully traverses the Examiner's obvious rejection of dependent claims 7-10 and 33-36 under 35 U.S.C. § 103(a) over the proposed combination of *Tenorio*, *Rajaraman*, *Riordan*, and *Murcko*, either individually or in combination.

For example, with respect to dependent claims 7-10, these claims recite:

7. The system of Claim 1, wherein ***the search interface is further operable to communicate***, in response to at least selection of the product class, ***a search query for product data only to one or more seller databases associated with sellers identified in a buyer profile.*** (Emphasis Added).

8. The system of Claim 7, wherein ***the buyer profile comprises a list of seller attribute criteria compiled based on one or more previous search requests.*** (Emphasis Added).

9. The system of Claim 7, wherein ***the buyer profile comprises a list of seller attribute criteria compiled based on one or more previous electronic transactions involving the buyer.*** (Emphasis Added).

10. The system of Claim 7, wherein:
the buyer profile comprises a list of seller attribute criteria; and
the search interface automatically updates the buyer profile at certain time intervals by eliminating from the buyer profile sellers no longer having seller attribute values matching the listed seller attribute criteria and adding to the buyer profile sellers having seller attribute values matching the listed seller attribute criteria. (Emphasis Added).

Dependent claims 33-36 recite similar limitations. *Tenorio, Rajaraman, Riordan, and Murcko*, either individually or in combination, fail to disclose, teach, or suggest each and every element of dependent claims 7-10 and 33-36.

The Applicant respectfully submits that the Office Action acknowledges, and Applicant agrees, that *Rajaraman* fails to disclose the emphasized limitations noted above. Specifically the Examiner acknowledges that ***Rajaraman fails to disclose "that seller attribute matches a buyer profile, a search query for product data only to seller databases associated with sellers identified in the buyer profile"*** or "***that a search query involves data of a buyer profile/preferences/habit.***" (19 October 2005 Office Action, Pages 4-5). However, the Examiner asserts that the cited portions of *Tenorio, Riordan, and Murcko* disclose the acknowledged shortcomings *Rajaraman*. (19 October 2005 Office Action, Pages 4-5). The Applicant respectfully disagrees. ***As mentioned above, Tenorio is disqualified as prior art under 35 U.S.C. § 103.*** Since, *Tenorio* is disqualified as prior art, it will not be discussed further. The Applicants respectfully traverse the Examiner's assertions regarding the subject matter disclosed in *Riordan* and *Murcko*.

The Applicant respectfully maintains that *Riordan* has nothing to do with the Applicant's claimed invention and in particular *Riordan* has nothing to do with the "***seller attribute matches a buyer profile, a search query for product data only to seller databases associated with sellers identified in the buyer profile***". Rather, *Riordan* describes an approach a merchant uses at a point of sale register to identify a preferred customer via a customer identification number. (Column 1, Lines 36-49). This approach merely allows a merchant to view data for a particular preferred customer using the customer's identification number. Thus, *Riordan* fails to disclose a ***search interface***

operable to communicate, in response to at least selection of the product class, a **search query for product data only to one or more seller databases associated with sellers identified in a buyer profile**, a **buyer profile that comprises a list of seller attribute criteria compiled based on one or more previous search requests, or a buyer profile that comprises a list of seller attribute criteria compiled based on one or more previous electronic transactions involving the buyer**.

The Applicant respectfully maintains that *Murcko* has nothing to do with the Applicant's claimed invention and in particular *Murcko* has nothing to do with a "search interface" that is "operable to communicate, in response to at least selection of the product class, a **search query for product data only to one or more seller databases associated with sellers identified in a buyer profile**." Rather, *Murcko* discloses "the flow of information and payments related to a given transaction in the system." (Column 22, Lines 21-23). *Murcko* does not disclose a **search interface operable to communicate**, in response to at least selection of the product class, a **search query for product data only to one or more seller databases associated with sellers identified in a buyer profile, a buyer profile that comprises a list of seller attribute criteria compiled based on one or more previous search requests, or a buyer profile that comprises a list of seller attribute criteria compiled based on one or more previous electronic transactions involving the buyer**.

In addition, the Applicant respectfully submits that the Office Action acknowledges, and Applicant agrees, that *Rajaraman*, *Riordan*, and *Murcko* fail to disclose the emphasized limitations noted above. Specifically the Examiner acknowledges that ***Rajaraman*, *Riordan*, and *Murcko* fail to disclose "the search interface automatically updates the buyer profile at certain time intervals** by eliminating from the buyer profile sellers no longer having seller attribute values matching the listed seller attribute criteria and adding to the buyer profile sellers having seller attribute values matching the listed seller attribute criteria." (19 October 2005 Office Action, Page 6). However, the Examiner asserts that the cited portions of *Tenorio* disclose the acknowledged shortcomings *Rajaraman*, *Riordan*, and *Murcko*. (19 October 2005 Office Action, Page 6). The Applicant respectfully disagrees. As

mentioned above, Tenorio is disqualified as prior art under 35 U.S.C. § 103. Since, *Tenorio* is disqualified as prior art, it will not be discussed further. Thus, the Applicant respectfully submits that the prior art forming the foundation of the Examiner's obvious rejection between *Rajaraman*, *Riordan*, and *Murcko* and dependent claims 10 and 36 cannot be made. The Applicant further submits that this distinction alone is sufficient to patentably distinguish dependent claims 10 and 36 from *Rajaraman*, *Riordan*, and *Murcko*.

The Applicant further submits that the Office Action has failed to properly establish a *prima facie* case of obviousness based on the proposed combination of *Tenorio*, *Rajaraman*, *Riordan*, and *Murcko*, either individually or in combination. The Office Action has not shown the required teaching, suggestion, or motivation in these references or in knowledge generally available to those of ordinary skill in the art at the time of the invention to combine *Tenorio*, *Rajaraman*, *Riordan*, and *Murcko* as proposed. The Office Action merely states that "it would have been obvious for one of ordinary skill in the art at the time of invention to combine *Tenorio*, *Rajaraman*, *Riordan*, and *Murcko* to suggest that a search query involves data of a buyer profile/preferences/habit". (19 October 2005 Office Action, Page 5). The Applicant respectfully disagrees.

The Applicant further submits that this purported advantage relied on by the Examiner is nowhere disclosed, taught, or suggested in *Tenorio*, *Rajaraman*, *Riordan*, and *Murcko*, either individually or in combination. In essence, the Examiner asserts that one of ordinary skill in the art at the time of the invention would have been motivated "because it accurately narrows down the search results to come up with a buyer preferred product and seller that fit with said buyer's requirement." (19 October 2005 Office Action, Page 5). The Applicant respectfully disagrees. ***The Applicant respectfully requests the Examiner to point to the portions of Tenorio, Rajaraman, Riordan, and Murcko which contain the teaching, suggestion, or motivation to combine Tenorio, Rajaraman, Riordan, and Murcko for the Examiner's stated purported advantage.*** The Applicant further submits that the Examiner is using the subject Application as a

template to formulate reconstructive hindsight, which constitutes impermissible use of hindsight under 35 U.S.C. § 103(a).

A recent Federal Circuit case makes it crystal clear that, in an obviousness situation, the ***prior art must disclose each and every element of the claimed invention***, and that ***any motivation to combine or modify the prior art must be based upon a suggestion in the prior art***. *In re Lee*, 61 U.S.P.Q.2d 1430 (Fed. Cir. 2002). (Emphasis Added). Conclusory statements regarding common knowledge and common sense are insufficient to support a finding of obviousness. *Id.* at 1434-35. With respect to the subject Application, the Examiner has not adequately supported the selection and combination of *Tenorio*, *Rajaraman*, *Riordan*, and *Murcko* to render obvious the Applicant's claimed invention. ***The Examiner's conclusory statements*** that "it would have been obvious for one of ordinary skill in the art at the time of invention to combine *Tenorio*, *Rajaraman*, *Riordan*, and *Murcko* to suggest that a search query involves data of a buyer profile/preferences/habit" and "because it accurately narrows down the search results", ***does not adequately address the issue of motivation to combine***. (19 October 2005 Office Action, Pages 4-5). This factual question of motivation is material to patentability, and cannot be resolved on subjective belief and unknown authority. *Id.* It is improper, in determining whether a person of ordinary skill would have been led to this combination of references, simply to "[use] that which the inventor taught against its teacher." *W.L. Gore v. Garlock, Inc.*, 721 F.2d 1540 (Fed. Cir. 1983). Thus, the Office Action fails to provide proper motivation for combining the teachings of *Tenorio*, *Rajaraman*, *Riordan*, and *Murcko*, either individually or in combination.

The Proposed *Tenorio-Rajaraman-Murcko-Official-Notice* Combination Fails to Disclose, Teach, or Suggest Various Limitations Recited in Applicant's Dependent Claims 3, 4, 6, 29, 30, and 32

The Applicant respectfully submits that *Tenorio*, *Rajaraman*, and *Murcko*, either individually or in combination, fail to disclose, teach, or suggest each and every element of dependent claims 3, 4, 6, 29, 30, and 32. Thus, the Applicant respectfully traverses the Examiner's obvious rejection of dependent claims 3, 4, 6, 29, 30, and 32 under 35 U.S.C.

§ 103(a) over the proposed combination of *Tenorio, Rajaraman, and Murcko*, either individually or in combination.

For example, with respect to dependent claims 3, 4, and 6, these claims recite:

3. The system of Claim 1, wherein ***the selection of the product class is made automatically according to a buyer profile for a buyer.*** (Emphasis Added).

4. The system of Claim 1, wherein ***the specification of the seller attribute criteria is made automatically according to a buyer profile for a buyer.*** (Emphasis Added).

6. The system of Claim 1, wherein ***seller attribute values for a seller are stored in the associated seller database along with product data.*** (Emphasis Added).

Dependent claims 29, 30, and 32 recite similar limitations. *Tenorio, Rajaraman, and Murcko*, either individually or in combination, fail to disclose, teach, or suggest each and every element of dependent claims 3, 4, 6, 29, 30, and 32.

The Applicant respectfully submits that the Office Action acknowledges, and Applicant agrees, that *Tenorio, Rajaraman, and Murcko* fail to disclose the emphasized limitations noted above. Specifically the Examiner acknowledges that *Tenorio, Rajaraman, and Murcko* fail to disclose the selection of the product class is made automatically according to a buyer profile for a buyer, the specification of the seller attribute criteria is made automatically according to a buyer profile for a buyer, and the seller attribute values for a seller are stored in the associated seller database along with product data. (19 October 2005 Office Action, Pages 6-7). However, the Examiner appears to be asserting Official Notice over the acknowledged shortcomings in *Tenorio, Rajaraman, and Murcko*. (19 October 2005 Office Action, Page 7). The Applicant respectfully disagrees. **As mentioned above, *Tenorio* is disqualified as prior art under 35 U.S.C. § 103.** Since, *Tenorio* is disqualified as prior art, it will not be discussed further. The Applicant respectfully traverses the Examiner's obvious rejection of dependent claims 3, 4, 6, 29, 30, and 32 under 35 U.S.C. § 103(a) over the proposed combination of *Tenorio, Rajaraman, Murcko*, and the Examiner's purported Official Notice, either individually or in combination.

The Applicant further submits that the Applicant is confused as to what the Examiner is intending to teach by the purported Official Notice or even the extent in which the Examiner is taking Official Notice. **The Applicant respectfully requests clarification as to the subject matter for which the Examiner is taking Official Notice.** The Examiner alleges that "providing an automatic means to replace a manual activity which accomplished the same result is not sufficient to distinguish over cited prior art". (19 October 2005 Office Action, Page 7). The Applicant respectfully traverses the purported Official Notice because the asserted facts, as best understood by the Applicant, are not supported by substantial documentary evidence or any type of documentary evidence and appear to be the Examiner's opinions formulated using the subject Application as a

template, which constitutes impermissible use of hindsight. Furthermore, under these circumstances, ***it is inappropriate for the Examiner to take Official Notice without documentary evidence to support the Examiner's conclusion.*** (See MPEP § 2144.03). The Applicants respectfully request the Examiner to produce authority for the Examiner's purported Official Notice.

Only "in limited circumstances," is it "appropriate for an examiner to take official notice of facts not in the record or to rely on common knowledge in making a rejection". (MPEP § 2144.03). "Official notice unsupported by documentary evidence should only be taken by the examiner where the facts asserted to be well-known, or to be common knowledge in the art are ***capable of instant and unquestionable demonstration as being well-known***. As noted by the court in *In re Ahlert*, 424 F.2d 1088, 1091, 165 USPQ 418, 420 (CCPA 1970), the notice of facts beyond the record which may be taken by the examiner must be '***capable of such instant and unquestionable demonstration as to defy the dispute***' (citing *In re Knapp Monarch Co.*, 296 F.2d 230, 132 U.S.P.Q. 6 (C.C.P.A. 1961))." (MPEP § 2144.03(A)). (Emphasis Added).

"It is never appropriate to rely solely on "common knowledge" in the art without evidentiary support in the record, as the principal evidence upon which a rejection was based. *Zurko*, 258 F.3d at 1385, 59 USPQ2d at 1697. As the court held in *Zurko*, an assessment of basic knowledge and common sense that is not based on any evidence in the record lacks substantial evidence support. *Id.* at 1385, 59 USPQ2d at 1697. See also *In re Lee*, 277 F.3d 1338, 1344-45, 61 USPQ2d 1430, 1434-35 (Fed. Cir. 2002)." (MPEP § 2144.03(A)).

"Ordinarily, there must be some form of evidence in the record to support an assertion of common knowledge. See *Lee*, 277 F.3d at 1344-45, 61 USPQ2d at 1434-35 (Fed. Cir. 2002); *Zurko*, 258 F.3d at 1386, 59 USPQ2d at 1697. (holding that ***general conclusions concerning what is "basic knowledge" or "common sense" to one of ordinary skill in the art without specific factual findings and some concrete evidence in the record to support these findings will not support an obviousness rejection.***) The examiner must provide specific factual findings predicated on sound

technical and scientific reasoning to support his or her conclusion of common knowledge. See *Soli*, 317 F.2d at 946, 37 USPQ at 801; *Chevenard*, 139 F.2d at 713, 60 USPQ at 241. The applicant should be presented with the explicit basis on which the examiner regards the matter as subject to official notice and be allowed to challenge the assertion in the next reply after the Office action in which the common knowledge statement was made.” (MPEP § 2144.03(B)). (Emphasis Added).

The Applicant respectfully submits that ***the Office Action provides no documentary evidence to support the purported Official Notice taken by the Examiner***, yet the asserted facts are not capable of “instant and unquestionable” demonstration as being well-known. The Applicants further submit that the Applicants have adequately traversed the Examiner’s assertion of Official Notice and direct the Examiner’s attention to the pertinent text of the MPEP, which states:

If applicant adequately traverses the examiner’s assertion of official notice, the examiner must provide documentary evidence in the next Office action if the rejection is to be maintained. See 37 CFR 1.104(c)(2). See also *Zurko*, 258 F.3d at 1386, 59 USPQ2d at 1697 (“[T]he Board [or examiner] must point to some concrete evidence in the record in support of these findings” to satisfy the substantial evidence test). If the examiner is relying on personal knowledge to support the finding of what is known in the art, the examiner must provide an affidavit or declaration setting forth specific factual statements and explanation to support the finding. See 37 CFR 1.104(d)(2). (MPEP § 2144.03(C)).

Thus, if the Examiner continues to maintain the rejection of dependent claims 3, 4, 6, 29, 30, and 32 based on the Examiner’s Official Notice, the Applicant respectfully requests that the Examiner provide documentary evidence as necessitated by MPEP § 2144.03(C). Furthermore, if the Examiner is relying on personal knowledge to support the finding of what is known in the art, the Applicants further request that the Examiner provide an Affidavit or Declaration setting forth specific factual statements and explanation to support the finding as further necessitated by MPEP § 2144.03(C).

In addition, the Applicant respectfully points the Examiner to the pertinent sections of the MPEP, directly on point to determine whether the next Office Action should be made

Final. In particular, the Applicant respectfully directs the Examiner's attention to MPEP § 2144.03(D), which states:

If the examiner adds a reference in the next Office action after applicant's rebuttal, and the newly added reference is added only as directly corresponding evidence to support the prior common knowledge finding, and it does not result in a new issue or constitute a new ground of rejection, the Office action may be made final. If no amendments are made to the claims, the examiner must not rely on any other teachings in the reference if the rejection is made final. If the newly cited reference is added for reasons other than to support the prior common knowledge statement and a new ground of rejection is introduced by the examiner that is not necessitated by applicant's amendment of the claims, the rejection may not be made final. (MPEP § 2144.03(D)).

The Applicant further submits that the Office Action has failed to properly establish a *prima facie* case of obviousness based on the proposed combination of *Rajaraman* and *Murcko*, either individually or in combination. The Office Action has not shown the required teaching, suggestion, or motivation in these references or in knowledge generally available to those of ordinary skill in the art at the time of the invention to combine *Rajaraman* and *Murcko* as proposed. The Office Action merely states that "it would have been obvious for one of ordinary skill in the art at the time of invention to combine *Tenorio*, *Rajaraman*, and *Murcko*". (7 October 2005 Office Action, Page 7). The Applicant respectfully disagrees.

The Applicant further submit that this purported advantage relied on by the Examiner is nowhere disclosed, taught, or suggested in *Rajaraman* and *Murcko*, either individually or in combination. In essence, the Examiner asserts that one of ordinary skill in the art at the time of invention would have been motivated "because it narrows down the search result [sic] to come up with a preferred product that fit [sic] with said buyer." (19 October 2005 Office Action, Page 7). The Applicant respectfully disagrees. ***The Applicant respectfully requests the Examiner to point to the portions of Rajaraman or Murcko which contain the teaching, suggestion, or motivation to combine Rajaraman or Murcko for the Examiner's stated purported advantage.*** The Applicant further submit that the Examiner is using the subject Application as a template to formulate

reconstructive hindsight, which constitutes impermissible use of hindsight under 35 U.S.C. § 103(a).

A recent Federal Circuit case makes it crystal clear that, in an obviousness situation, the ***prior art must disclose each and every element of the claimed invention***, and that ***any motivation to combine or modify the prior art must be based upon a suggestion in the prior art***. *In re Lee*, 61 U.S.P.Q.2d 1430 (Fed. Cir. 2002). (Emphasis Added). Conclusory statements regarding common knowledge and common sense are insufficient to support a finding of obviousness. *Id.* at 1434-35. With respect to the subject Application, the Examiner has not adequately supported the selection and combination of *Rajaraman* or *Murcko* to render obvious the Applicant claimed invention. ***The Examiner's conclusory statements*** that "it would have been obvious for one of ordinary skill in the art at the time of invention to combine *Tenorio*, *Rajaraman*, and *Murcko* to use a buyer profile for searching in addition to a buyer's query" and "because it narrows down the search result", ***does not adequately address the issue of motivation to combine***. (7 October 2005 Office Action, Page 9). This factual question of motivation is material to patentability, and cannot be resolved on subjective belief and unknown authority. *Id.* It is improper, in determining whether a person of ordinary skill would have been led to this combination of references, simply to "[use] that which the inventor taught against its teacher." *W.L. Gore v. Garlock, Inc.*, 721 F.2d 1540 (Fed. Cir. 1983). Thus, the Office Action fails to provide proper motivation for combining the teachings of *Rajaraman* or *Murcko*, either individually or in combination.

The Applicant's Claims are Patentable over the Proposed *Tenorio-Rajaraman-Riordan-Murcko-Official-Notice* Combination

Independent claims 27, 41, and 43 each includes limitations similar to those discussed above in connection with independent claim 1. Thus, independent claims 27, 41, and 43 are considered patentably distinguishable over the proposed combination of *Tenorio*, *Rajaraman*, *Riordan*, and *Murcko*, for at least the reasons discussed above in connection with independent claim 1.

With respect to dependent claims 2-10 and 28-36, claims 2-10 depend from independent claim 1 and claims 28-36 depend from independent claim 27. As mentioned above, each of independent claims 1, 27, 41 and 43 are considered patentably distinguishable over the proposed combination of *Tenorio*, *Rajaraman*, *Riordan*, and *Murcko*. Thus, dependent claims 2-10 and 28-36 are considered to be in condition for allowance for at least the reason of depending from an allowable claim.

For the reasons set forth herein, the Applicant submits that claims 1-10, 27-36, 41, and 43 are not rendered obvious by the proposed combination of *Tenorio*, *Rajaraman*, *Riordan*, and *Murcko*. The Applicant further submits that claims 1-10, 27-36, 41, and 43 are in condition for allowance. Thus, the Applicant respectfully requests that the rejection of claims 1-10, 27-36, 41, and 43 under 35 U.S.C. § 103(a) be reconsidered and that claims 1-10, 27-36, 41, and 43 be allowed.

THE LEGAL STANDARD FOR OBVIOUSNESS REJECTIONS UNDER 35 U.S.C. § 103:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991); M.P.E.P. § 2142. Moreover, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (CCPA 1974). If an independent claim is nonobvious under 35 U.S.C. § 103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988); M.P.E.P. § 2143.03.

With respect to alleged obviousness, there must be something in the prior art as a whole to suggest the desirability, and thus the obviousness, of making the combination. *Panduit Corp. v. Dennison Mfg. Co.*, 810 F.2d 1561 (Fed. Cir. 1986). In fact, the absence

of a suggestion to combine is dispositive in an obviousness determination. *Gambro Lundia AB v. Baxter Healthcare Corp.*, 110 F.3d 1573 (Fed. Cir. 1997). The mere fact that the prior art can be combined or modified does not make the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 U.S.P.Q.2d 1430 (Fed. Cir. 1990); M.P.E.P. § 2143.01. The consistent criterion for determining obviousness is whether the prior art would have suggested to one of ordinary skill in the art that the process should be carried out and would have a reasonable likelihood of success, viewed in the light of the prior art. Both the suggestion and the expectation of success must be founded in the prior art, not in the Applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991); *In re O'Farrell*, 853 F.2d 894 (Fed. Cir. 1988); M.P.E.P. § 2142.

A recent Federal Circuit case makes it clear that, in an obviousness situation, the prior art must disclose each and every element of the claimed invention, and that any motivation to combine or modify the prior art must be based upon a suggestion in the prior art. *In re Lee*, 61 U.S.P.Q.2d 1430 (Fed. Cir. 2002). Conclusory statements regarding common knowledge and common sense are insufficient to support a finding of obviousness. *Id.* at 1434-35.

CONCLUSION:

In view of the foregoing amendments and remarks, this application is considered to be in condition for allowance, and early reconsideration and a Notice of Allowance are earnestly solicited.

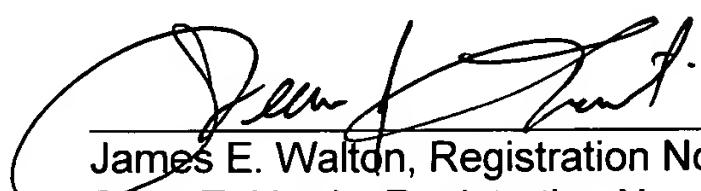
Although Applicant believe no fees are deemed to be necessary; the undersigned hereby authorizes the Director to charge any additional fees which may be required, or credit any overpayments, to **Deposit Account No. 500777**.

Please link this application to Customer No. 53184 so that its status may be checked via the PAIR System.

Respectfully submitted,

1/19/06

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